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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/006,279	12/04/2001	Juan C. Colberg	PC10862A	2249

23913 7590 08/27/2003

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EXAMINER

BERCH, MARK L

ART UNIT	PAPER NUMBER
1624	13

DATE MAILED: 08/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)
	10/006,279	COLBERG ET AL.
	Examiner	Art Unit
	Mark L. Berch	1624

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 August 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) The period for reply expires ____ months from the mailing date of the final rejection.
- b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. A Notice of Appeal was filed on 8/14/03. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. The proposed amendment(s) will not be entered because:
 - (a) they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) they raise the issue of new matter (see Note below);
 - (c) they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. Applicant's reply has overcome the following rejection(s): _____.
4. Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. The a) affidavit, b) exhibit, or c) request for reconsideration has been considered but does NOT place the application in condition for allowance because: See memo.
6. The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. For purposes of Appeal, the proposed amendment(s) a) will not be entered or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: 12 and 17-19.

Claim(s) rejected: 1-11,13-16 and 20-24.

Claim(s) withdrawn from consideration: _____.

8. The proposed drawing correction filed on _____ is a) approved or b) disapproved by the Examiner.
9. Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. Other: _____

Mark L. Berch
Primary Examiner
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DETAILED ACTION

The request for reconsideration filed 8/14/2003 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance.

The sole difference between the prior art reaction and the claimed reaction is that the examples of the prior art do the acylation with the 4-carboxy group in the ester form, whereas applicants do the reaction in the acid or salt form. The reference teaches the equivalence of the salt/acid and esters forms. It is noted that the reaction does not take place at this position, but elsewhere.

The traverse is unpersuasive. Applicants note that the prior art uses mesyl chloride, and allege, without evidence, that the cryogenic conditions are necessitated by the use of this "highly unstable compound". Applicants by contrast use normal temperature. This argument is confused. The mesyl chloride is only used to activate the acylating agent, i.e. to convert it into the acid chloride form. In the claim, the acylating agent is already in the activated form, i.e. L can be Cl. Thus, the claims as written also embrace a situation where the R²L reagent is prepared by reacting the R²OH with the same mesyl-Cl. In that case, applicants too would be using the same cryogenic conditions for the same reasons. In other words, applicants are looking at a step --- the activation of the acylating reagent with mesyl-Cl --- which is not recited in the claim. Patentability cannot be based on difference in a step which is not recited. It is true that applicants use a different activation technique in Method A on page 27. But that activation step is not present in the claim, and patentability cannot be based on it.

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And even if it were, as noted previously, there is no temperature limitation in the claims, so the claims also read on doing this reaction under cryogenic conditions.

Patentability cannot be based on a (temperature) limitation which is not actually recited.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark L. Berch whose telephone number is 703-308-4718. The examiner can normally be reached on M-F 7:15 - 3:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 308-4716. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 708-308-1235.



Mark L. Berch
Primary Examiner
Art Unit 1624

August 21, 2003